

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	
	)	
Anthony G. Lutfallah	)	
	)	
Application No. 10/752,406	)	Examiner: Carlos Lugo
	)	
Confirmation No. 3878	)	Art Unit 3676
	)	
Filed January 6, 2004	)	
	)	
For: Universal Stop for a Slidable Window	)	

**APPELLANT'S SECOND REPLY BRIEF**

MAIL STOP APPEAL BRIEF - PATENTS  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

This constitutes Applicant's second Reply Brief on appeal, in response to the second Examiner's Answer mailed on October 3, 2007. This Reply Brief is timely filed. The information specified by 37 C.F.R. § 41.41 and M.P.E.P. 1208 is provided hereunder.

As an initial matter, the Examiner is thanked for the careful analysis that has been given in both of the Examiner's Answers. Nonetheless, the Examiner's Answers do not provide sufficient reason for maintaining the rejections of the claims of the present application. For the reasons that follow, the Examiner's rejections should be reversed.

**I. STATUS OF CLAIMS**

Twenty-nine (29) claims were originally filed in the application, and six (6) were added in prosecution. Claims 24, 30-33, 35, and 36 are pending for appeal. All pending claims have been rejected. A detailed status of the claims is as follows:

- A. Claims originally filed: 1-29
- B. Claims canceled: 1-23, 25-29, and 34
- C. Claims added: 30-36
- D. Claims currently pending: 24, 30-33, 35, and 36
- E. Claims allowed: None
- F. Claims rejected: 24, 30-33, 35, and 36
- G. Claims objected to: None
- H. Claims on appeal: 24, 30-33, 35, and 36

The independent claims in this application are 24, 30, 35, and 36. Each of the claims involved in this Appeal (24, 30-33, 35, and 36) are included in the attached Appendix.

## **II. GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

The following grounds of rejection are to be reviewed on appeal:

1. Whether claims 24, 30-33, 35, and 36 were properly rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,806,900 to Bratcher *et al.* (“Bratcher”) in view of U.S. Patent No. 6,575,681 to Kojima *et al.* (“Kojima”).
2. Whether claim 36 was properly rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,806,900 to Bratcher *et al.* (“Bratcher”) in view of U.S. Patent No. 6,575,681 to Kojima *et al.* (“Kojima”).

### III. ARGUMENTS

#### A. Rejection of Claims 24, 30-33, 35, and 36 as Obvious Over U.S. Patent No. 5,806,900 (“Bratcher”) in view of U.S. Patent No. 6,575,681 (“Kojima”)

The Examiner has rejected claims 24, 30-33, 35, and 36 under 35 U.S.C. § 103(a) as being unpatentable over Bratcher in view of Kojima. As in the Appeal Brief and the first Reply Brief, Applicants address claims 24, 30-33, and 36 together as a group and claim 35 separately.

##### 1. **Claims 24, 30-33, and 36**

###### a. **Kojima is Non-Analogous Art and Not Properly Combinable With Bratcher**

Appellant believes no additional argument is necessary on this basis, and chooses to rely fully upon the arguments presented in the Appeal Brief and the first Reply Brief.

###### b. **Bratcher and Kojima Are Not Properly Combinable Because There Is No Motivation To Combine The Teachings Of The References**

Appellant restates that the Examiner has not established a *prima facie* case of obviousness with respect to claims 24, 30-33, and 36 on the basis that Bratcher and Kojima are not properly combinable to form an obviousness rejection, because there is no motivation to combine the teachings of the cited references. Appellant submits brief additional arguments in light of the Examiner’s second Answer and the Supreme Court’s recent decision in *KSR Int’l. Co. v. Teleflex, Inc.*, 82 U.S.P.Q.2d 1385 (U.S. 2007).

The Examiner states, in the second Answer, that “a conclusion of obviousness may be made from common knowledge and common sense ... without any specific hint or suggestion in a particular reference.” (Second Answer, P. 4). However, the Court in *KSR* acknowledged that “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art,” and “it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.... because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.” *KSR*, 82 U.S.P.Q.2d at 1396. Thus, the Court’s decision in *KSR* does not relieve the Examiner of the responsibility to

provide “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (cited favorably in *KSR*, 82 U.S.P.Q.2d at 1396).

Appellants again submit that the Examiner’s rejections constitute hindsight reconstruction, because one skilled in the art would not have been prompted to modify Bratcher with Kojima in the manner proposed by the Examiner without first having the benefit of Appellant’s disclosure. This is particularly true in view of the fact that Kojima exists in a technical field that is far removed from that of Appellant’s invention. The Court in *KSR* warned of “the distortion caused by hindsight bias,” and urged caution with respect to “arguments reliant on *ex post* reasoning.” *KSR*, 82 U.S.P.Q.2d at 1397. Appellant again submits that hindsight provides the only basis for combining the references as proposed by the Examiner to reject Appellant’s claims, and hindsight cannot provide a proper basis for combination of references.

Accordingly, Bratcher and Kojima are not properly combinable to form an obviousness rejection, and the Examiner’s rejection of claims 24, 30-33, and 36 over the combination of Bratcher and Kojima is improper.

## **2. Claim 35**

### **a. Bratcher and Kojima Do Not Disclose A Planar Engagement Surface Extending From An Inner Edge To An Outer Edge**

Appellant believes no additional argument is necessary on this basis, and chooses to rely fully upon the arguments presented in the Appeal Brief and the first Reply Brief.

Appellant also submits, as stated above, that Bratcher and Kojima are not properly combinable to form an obviousness rejection of claim 35.

### **B. Rejection of Claim 36 as Obvious Over U.S. Patent No. 5,806,900 (“Bratcher”) in view of U.S. Patent No. 6,575,681 (“Kojima”)**

In the Examiner’s first Answer, claim 36 was rejected over Bratcher in view of Kojima, as well as Bratcher in view of U.S. Patent No. 6,250,694 to Weiland (“Weiland”). The Examiner’s second Answer (October 3, 2007) has been corrected, thereby removing the rejection of claim 36 over Bratcher in view of Weiland. Since claim 36 was previously rejected over Bratcher in view of Kojima in the first Answer, Appellant previously addressed the Examiner’s rejections over Bratcher in view of Kojima in Section III.A.1 of Appellant’s first

Reply Brief (September 25, 2007). Thus, Appellant believes no additional argument is necessary on this basis, and chooses to rely fully upon the arguments presented in the Appeal Brief and the first Reply Brief, as well as in Section III.A.1 above.

#### IV. CONCLUSION

For the foregoing reasons, Appellant again respectfully requests that the Board reverse the Examiner's rejections, and order that claims 24, 30-33, 35, and 36 be passed to issue.

Respectfully submitted,

Date: December 3, 2007

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